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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/511,162

10/14/2004

Helmut Winterling

53429

9022

26474

7590

08/21/2007

NOVAK DRUCE DELUCA & QUIGG, LLP

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EXAMINER

ZEMEL, IRINA SOPJIA

ART UNIT

PAPER NUMBER

1711

MAIL DATE

DELIVERY MODE

08/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/511,162

Applicant(s)

WINTERLING ET AL.

Examiner

Irina S. Zemel

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1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mohrschladt et al USP 6,316,588 or Mohrschladt et al (USP 6,288,207).

The rejection stands as per reasons of record.

Response to Arguments

Applicant's arguments filed 5-8-2007 and 6-18-2007 have been fully considered but they are not persuasive. The applicants arguments are directed to the fact that the closest prior art examples disclosed in the cited references are examples that employ catalyst with BET of 50 m²/g and not 46 m²/g, and that the comparative examples presented in the instant specification (page 14-15) that use catalyst with BET surface area of 50 m²/g does reflect the closest prior art examples. Thus, the showing presented in the application are sufficient and commensurate in scope with the presently claimed invention.

Even if, arguendo, the examine is to agree that the closest prior art exemplified by the references does use catalyst with BET surface area of 50 m²/g (as in the

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comparative examples of the instant application), the examiner, once gain, emphasizes that the results presented on pages 14-5 of the specification are NOT considered to be unexpected. The results presented in the specification (examples 1-2 and comparative example 1), relate to the amounts of catalyst in the final product, and those results, as discussed in the previous office actions, are NOT unexpected. In fact, as again was discussed in several previous office actions, this is quite expected as it is known in the art of catalysts that smaller size catalyst particles (particles having higher BET area) gets trapped in the final polymeric product more easily, thus the amount of smaller size catalyst is expected to be higher in the final product as compared to the catalyst of the larger particle size.

What was considered unexpected, as indicated by the Examiner in previous discussions, was the allegations by the applicants that the catalytic activity of the catalyst with smaller BET (as per claimed limitations) does not decrease as compared to the catalytic activity of the larger BET area catalysts. The Examiner noted the statement to that effect in the paragraph bridging pages 13 and 14 of the instant application. However, this statement is just that – an applicants' statement which is NOT supported by any evidence. The factual evidence of unexpected results is necessary in order to determine whether the alleged results are clearly unexpected and of the probative value of the evidence outweigh the expected results. In addition, it is also necessary that the evidence of unexpected results be commensurate in scope with the claimed invention. It is noted, that the original claims and the specification referred to the upper limit of 35 as within the scope of the "present invention" (as per statement

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on page 13), and not the presently claimed 30 m²/g. Thus, even the unsupported statement on pages 13-14 seems to be referring to the broader scope of invention than now claimed.

Once again, in the absence of clear showing of results that would be considered unexpected, the invention as claimed is still considered to have been obvious from the disclosure of the cited references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

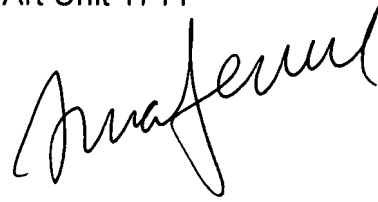
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Irina S. Zemel

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Primary Examiner
Art Unit 1711

ISZ

A handwritten signature in black ink, appearing to read "M. J. Ferrell", is written over the printed name of the Primary Examiner.